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**THIS DISPOSITION
IS NOT CITABLE AS PRECEDENT
OF THE T.T.A.B.**

Paper No. 16
EWH/KRD

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Wade Charles Barnett

Serial No. 75/255,424

Timothy D. Pecsenty of Blank, Rome, Comisky & McCauley, LLP
for Wade Charles Barnett.

Wm. Patrick Shanahan, Trademark Examining Attorney, Law
Office 113 (Odette Bonnet, Managing Attorney).

Before Seeherman, Hanak and Rogers, Administrative
Trademark Judges.

Opinion by Hanak, Administrative Trademark Judge:

Wade Charles Barnett (applicant) seeks to register
LENDING SOLUTIONS FOR CREDIT UNION MEMBERS in typed drawing
form for "financial services, namely relationship
investment banking." The intent-to-use application was
filed on March 11, 1997.

Citing Section 2(e)(1) of the Trademark Act, the
examining attorney has refused registration on the basis

that applicant's mark is merely descriptive of applicant's services.

When the refusal to register was made final, applicant appealed to this Board. Applicant and the examining attorney filed briefs. Applicant did not request a hearing.

As has been stated repeatedly, "a term is merely descriptive if it forthwith conveys an immediate idea of the ingredients, qualities or characteristics of the goods [or services]." In re Abcor Development Corp., 588 F.2d 811, 200 USPQ 215, 218 (CCPA 1978) (emphasis added); Abercrombie & Fitch Co. v. Hunting World, Inc., 537 F.2d 4, 189 USPQ 759, 765 (2nd Cir. 1976). Moreover, the immediate idea must be conveyed forthwith with a "degree of particularity." In re TMS Corp. of the Americas, 200 USPQ 57, 59 (TTAB 1978); In re Entenmann's Inc., 15 USPQ2d 1750, 1751 (TTAB 1990), aff'd 90-1495 (Fed. Cir. February 13, 1991).

Applicant's services are investment banking. Applicant has made of record excerpts from the Dictionary of Investment Terms (1998). This dictionary defines "investment banking" as "what an investment bank does." The term "investment bank" is defined as "an individual or institution which acts as an underwriter or agent for

corporations and municipalities issuing securities, but which does not accept deposits or make loans."

Thus, by definition investment banking services do not include the making of loans. Hence, the term LENDING SOLUTIONS in applicant's mark LENDING SOLUTIONS FOR CREDIT UNION MEMBERS creates a degree of ambiguity when said mark is used in connection with investment banking services. It is only by means of using a lengthy reasoning process that one discerns how applicant provides lending solutions to credit unions and their members. In a paper dated July 20, 1999, applicant explained how his services were rendered in the following fashion: "In layman's terms, an investment banker will take several loans that are owned and issued by a [financial institution] and bundle them and sell them to another investor. ... Applicant's targeted customer base consists of credit unions that make loans to consumers. Applicant's service purchases the loans from credit unions and sells them to sophisticated investors. ... This service provides credit unions with immediate money, instead of having to wait for the borrower to repay the loan over the life of the loan. Also, it provides investors with a stable stream of income for a set number of years. In the end both parties get what they desire; the credit union

gets paid immediately and the investor has acquired a stable security."

At page four of his brief, the examining attorney has acknowledged that the forgoing explanation of applicant's investment banking services is an accurate explanation. The examining attorney then argues that because applicant acknowledges that it provides services to credit unions that will help solve their lending problems, that therefore applicant's mark LENDING SOLUTIONS FOR CREDIT UNION MEMBERS is merely descriptive of investment banking services.

We simply disagree. In our view, even very sophisticated credit union officers and investors, upon seeing the mark LENDING SOLUTIONS FOR CREDIT UNION MEMBERS used in connection with investment banking services, would have to give considerable thought to the mark before arriving at some idea as to the nature or characteristic of applicant's particular investment banking services. Indeed, because investment banks do not make loans, some sophisticated officers and investors may never understand what characteristic or feature of investment banking services is conveyed forthwith by applicant's mark. As noted earlier, the presence of the term "lending solutions" in applicant's mark would cause many sophisticated credit union officers and investors to view applicant's mark as

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being incongruous when applied to investment banking services.

Decision: The refusal to register is reversed.